

Applicants: Stephen P. Goff and Guangxia Gao
U.S. Serial No.: 10/568,396
Filed: August 31, 2006
Page: 4 of April 8, 2009 Amendment in Response to March 12,
2009 Office Action

REMARKS

Applicants have hereinabove cancelled claims 8-19 without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in the future. Applicants have also hereinabove amended claim 37 to depend from claim 1, and applicants have added new claims 57-61, which correspond to original claims 38-42, respectively. Claim 57 is dependent on claim 37. Claim 58 is dependent on claim 1 and claims 59-61 are dependent on claim 58. Applicants maintain that the amendments to the claims raise no issue of new matter. Accordingly, applicants respectfully request that this Amendment be entered.

Restriction Requirement Under 35 U.S.C. §§121 and 372

In the March 12, 2009 Office Action, the Examiner imposed a restriction requirement under 35 U.S.C. §§121 and 372 among the following three allegedly independent and distinct inventions:

- I. Claims 1 to 7 drawn to an isolated ZAP protein;
- II. Claims 8 to 19 drawn to an isolated polynucleotide encoding a ZAP protein; and
- III. Claim 37 drawn to a method of increasing the amount of ZAP protein in a subject comprising administering to said subject ZAP protein.

In response, applicants elect, with traverse, Examiner's Group I, i.e. claims 1 to 7, drawn to an isolated ZAP protein.

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Additionally, applicants note the Examiner's advisory of rejoinder on pages 3-4. As indicated above, claim 37, has been amended to depend from claim 1. In addition, applicants have added new claims 57-61 which correspond to original claims 38-42, respectively, and which also depend from claim 1. Accordingly, applicants understand new claims 57-61 to fall within Group III as identified by the Examiner in the March 12, 2009 Office Action. Applicants have elected a product (Group I) for initial examination and look forward to rejoinder of the process of the use claims (Group III) upon allowance of the elected product in compliance with 37 C.F.R. §1.141.

The Examiner stated that "the inventions are distinct, each from the other."

Applicant notes that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require application to be restricted to one of the inventions." [Emphasis added]. Applicant requests that the restriction requirement be withdrawn in view of the fact that the claims of Groups I-III are not independent. Under M.P.E.P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect...". The claims of Groups I-III are related in that the pending claims are all drawn to methods or compositions relating to ZAP protein.

Applicant therefore respectfully asserts that two or more independent and distinct inventions have not been claimed in

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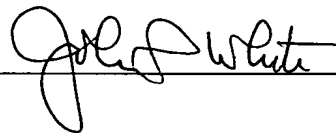
the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine the pending claims on the merits.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.


No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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 4/8/09
John P. White Date
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